

Serial Number: 09/954,666

Docket Number: 10007341-1

**REMARKS**

Upon entry of this Response, claims 6, 14, 21, 24-33 remain pending in the present application. Claims 6, 14, 21, 24-27 have been amended, claims 28-33 have been added, and claims 2-5, 7-8, 10-13, 15, 17-20, and 22-23 have been canceled. Applicants request reconsideration of the pending claims in view of the following remarks.

In item 2 of the Office Action, claims 2-6, 10-14, and 17-21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,564,051 issued to Halliwell et al. (hereafter "Halliwell") in view of U.S. Patent 5,793,966 issued to Amstein et al. (hereafter "Amstein"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Applicants note that claims 2-5, 10-13, and 17-20 have been canceled herein, thereby rendering this grounds of rejection moot with respect to such claims. Applicants assert that the cited combination of Halliwell and Amstein fails to show or suggest each of the elements of claims 6, 14, and 21 as amended herein for the reasons that follow.

To begin, claim 6 has been amended to recite as follows:

6. A method for obtaining a font, comprising the steps of:

- examining a digital document in a printer to identify a font included therein, wherein the digital document is to be rendered by the printer, the printer being coupled to an Internet;
- determining if the font is available in the printer;
- implementing in the printer a search of at least one server on the Internet for the font in order to render the digital document if the font is unavailable in the printer by:
  - consulting a lookup table in the printer, the lookup table identifying at least one universal resource locator (URL) of the at least one server on the Internet; and
  - searching the at least one server to determine if the font is located on the at least one server;
  - automatically downloading the font from the at least one server if the font is found on the at least one server; and
  - automatically attempting to install the font in the printer.

As set forth above, claim 6 includes the element of "consulting a lookup table in the printer, the lookup table identifying at least one universal resource locator of

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the at least one server on the Internet". In this respect, the Office Action states that Amstein shows "consulting a directory that associates a service with a remote device being typical for on-line services (col. 1, lines 24-32)." (Office Action, page 3)

Applicants respectfully disagree. Specifically, at col. 1, lines 24-41 inclusive of the cited portion above, Amstein states:

"Typical uses for on-line services include document viewing, electronic commerce, directory lookup, on-line classified advertisements, reference services, electronic bulletin boards, document retrieval, electronic publishing, key word searching of documents, technical support for products, and directories of on-line services, among others. The service may make the information available free of charge, or for a fee and maybe on publicly accessible or private computer systems.

Information services managed by the server may include files, databases and applications on the server system or on an external computer system. The information that the server provides simply may be stored on the server, may be converted from other formats manually or automatically, may be computed on the server in response to a client request, may be derived from data and applications on the server or other machines, or may be derived by any combination of these techniques."

As set forth above Amstein discusses "typical uses for on-line services". In this regard, directory lookups are performed by servers on a network. In contrast, claim 6 has been amended to provide for consulting a lookup table in the printer where the lookup table identifies universal resource locators (URLs) of servers on the Internet to be searched for a font. The lookup table is stored locally in the printer as it is important for the printer to be able to perform a search quickly to determine if it can find a font that is currently not available locally in the printer in order to print out a document that was sent to the printer.

As such, the printer includes all of the relevant URLs in the lookup table to be searched for a font so that the printer can directly interface with various locations on the Internet to search for a desired font for the printing of a document for which the printer lacks a font in the font directory. Thus, the printer need not rely upon a directory in a separate device on the Internet that may not be operating at the time the printer wishes to search for a particular font. If such a site were not operating, the printer would not be able to search for fonts that it did not have, and consequently, the printer would not be able to print out a document in a proper manner as desired by a user with the fonts specified in the digital document itself.

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Accordingly, Applicants assert that the cited combination of Halliwell and Amstein fails to show or suggest each of the elements of claim 6 as amended. In addition, Applicants assert that the cited combination of Amstein and Halliwell fails to show or suggest each of the elements of claims 14 and 21 to the extent that they incorporate subject matter similar in scope with that of claim 6 above. Accordingly, Applicants request that the rejection of claims 6, 14, and 21 be withdrawn. In addition, Applicants request that the rejection of claims 25, 26, and 27 be withdrawn as depending from claims 6, 14, and 21, respectively.

Next, in item 8 of the Office Action, claim 24 has been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,073,147 issued to Chan et al. (hereafter "Chan") in view of Amstein. Applicants note that claim 24 has been amended to recite subject matter similar in scope with that of claim 6 above. Accordingly, Applicants request that the rejection of claim 24 be withdrawn for the same reasons discussed with reference to claim 6 above.

Next, in item 10 of the Office Action, claim 7, 8, 15, 22, and 23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Halliwell in view of Amstein and further in view of Chan. Applicants note that claims 7, 8, 15, 22, and 23 have been canceled herein, thereby rendering this grounds of rejection moot.

Next in item 13, claims 25-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Halliwell in view of Amstein, and further of U.S. Patent 6,269,377 issued to Collie et al. (hereafter "Collie"). Given that claims 25-27 depend from claim 6, 14, and 21, respectively, Applicants request that the rejection of claims 25-27 be withdrawn for the same reasons discussed above with respect to claims 6, 14, and 21.

In addition, Applicants note that claims 28-33 have been added herein to further claim various embodiments of the present invention. Favorable action with respect to these claims is requested.

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Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,



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